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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/211,755 12/15/98 JONES

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EXAMINER

BRANNOCK, M

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

03/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/211,755

Applicant(s)

Jones, KA

Examiner

Michael Brannock, Ph.D.

Group Art Unit

1646

☒ Responsive to communication(s) filed on Feb 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 190-249 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 190-249 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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*Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 190-207, 246 and 249, drawn to a method for identifying ligands of a GABA<sub>B</sub>R1/R2 receptor and a process of preparing a pharmaceutical composition, classified in class 436, subclass 501.
  - II. Claims 208, 210, 213, 214, 221-225, 228-231, 233 and 234-240 drawn to a method for identifying agonists of a GABA<sub>B</sub>R1/R2 receptor, classified in class 436, subclass 501.
  - III. Claims 209, 210, 215-223, 226-230 and 232-240, drawn to a method for identifying antagonists of a GABA<sub>B</sub>R1/R2 receptor, classified in class 436, subclass 501.
  - IV. Claims 211 and 241, 247 and 249 drawn to a composition comprising an agonist and a process of preparing a pharmaceutical composition, classification dependent on the chemical nature of the agonist.
  - V. Claims 212 and 241, 248 and 249 drawn to a composition comprising an antagonist and a process of preparing a pharmaceutical composition, classification dependent on the chemical nature of the antagonist.
  - VI. Claims 242 and 245, drawn to a process for identifying and synthesizing a compound, classification dependent on the chemical nature of the compound.

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VII. Claims 243 and 245, drawn to a process for identifying and synthesizing an agonist, classification dependent on the chemical nature of the agonist.

VIII. Claims 244 and 245 drawn to a process for identifying and synthesizing an antagonist, classification dependent on the chemical nature of the antagonist.

Note: claims that appear in more than one group will be searched only as they relate to the elected Group. For example: if Group IV is elected, then claim 241 would only be examined to the extent that it reads on an agonist. If is Group V is elected, then claim 241 would only be examined to the extent that it reads on an antagonist.

2.The inventions are distinct, each from the other because of the following reasons:

Groups II and III are related to Groups IV and V, respectively, as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the agonist of Group IV and the antagonist of group V are products that could potentially be acquired through sources unrelated to the methods of either Group II or Group III, e.g. the compounds could be obtained though commercial sources if these compounds were known in the art. Additionally, Groups VII and VIII are related to Groups IV and V, respectively, as process of making and product made. Again, the agonist of Group IV and the

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antagonist of group V are products that could be acquired through sources unrelated to the methods of either Group VII or Group VIII, e.g. the compounds could be obtained through commercial sources if these compounds were known in the art. Further the agonist of Group IV is patentably distinct from the methods of Groups I, III, VI, and VIII, because one is not required of the other. Similarly the antagonist of Group V is patentably distinct from the methods of Groups I, II, VI, and VII, because one is not required of the other.

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups IV and V are directed to products that are distinct, both physically and functionally, and are not required one for the other, and are therefore patentably distinct. Further, the agonist of Group IV and the antagonist of Group V, would be expected to have different chemical structures, and, by definition, to have opposite or divergent effects in a biological system.

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups I and VI are directed to methods that are distinct both physically and functionally from the methods of Groups II, III, VII and VIII, and are not required one for the other. Groups I and VI require an assay of binding which is not required of Groups II, III, VII

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and VIII. Further, Groups II, III, VII and VIII require an assay of function, which is not required by Groups I and VI.

Additionally, the methods of Groups I, II, and III are distinct from the methods of Groups VI, VII, and VIII because the methods of Groups VI, VII, and VIII require the additional step of synthesis which is not required of Groups I, II, and II. Further, the methods of Groups VI, VII, and VIII are each patentably distinct, one from the other, because each requires the chemical synthesis of structurally distinct compounds. Finally, the methods of Group II for identifying and agonist and the methods Group III for identifying and antagonist are patentably distinct because the goal of each is to identify structurally distinct compounds with opposite and divergent biological functions.

Therefore, a search and examination of all of the groups in one patent application would result in an undue burden, since the searches for the eight groups are not co-extensive, the classification is different, and/or the subject matter is divergent.

3. A telephone call was made to John White on 3/7/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D., can be reached at (703) 308- 4623.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Elizabeth C. Kemmerer*

MB



March 10, 2000

ELIZABETH KEMMERER  
PRIMARY EXAMINER